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| SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192 | | | | BARQADLE, YASIN M |
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/682,853
Filing Date: October 24, 2001
Appellant(s): Scott C. Harris

MAILED

SEP 22 2006

Technology Center 2100

Scott C. Harris
Reg. No. 32,030
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 03, 2006
appealing from the Office action mailed October 04, 2005.

REAL PARTY IN INTEREST

A statement identifying the real party in interest is
contained in the brief.

(RELATED APPEALS AND INTERFERENCES)

A statement identifying the related appeals and
interferences, which will directly affect or be directly

affected by or have a bearing on the decision in the pending appeal is contained in the brief.

STATUS OF THE CLAIMS

The statement of the status of the claims contained in the brief is correct.

STATUS OF AMENDMENT

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

SUMMARY OF INVENTION

The summary of invention contained in the brief is correct.

ISSUES

The appellant's statement of the issues in the brief is correct.

GROUND OF REJECTION

Claims 1-3, 5-10, 13, 14, 16-21 and 23 are rejected under 35 U.S.C. 103 as being obvious over Chen in view of Steele.

Claims 8-10 are rejected under 35 U.S.C. 103 as being obvious over Chen in view of Rajan.

CLAIMS APPEALED

The copy of the appealed claims contained in the appendix pages 1-3, 5-10, 13, 14, 16-21 and 23 is correct.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-8, 16-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al US. PUB. (20020177453) in view of Steele et al USPUB (20020046084).

As per claim 1, Chen et al teach a method, comprising:

sending a request for information from an interactive device (Fig. 1, 214) to a first recipient (Fig. 1, 100) [Page 1, paragraphs 0009-0013];

at said first recipient, using information from said request to query a publicly accessible source of information

(Fig.5, 352) [Page 1, paragraphs 0011-0014];

receiving results from querying said source of information, reformatting said results into a new form [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058]; and

sending said results in said new form to said interactive device [Page 1, paragraphs 0011-0014].

Although Chen et al shows substantial features of the claimed invention, he does not explicitly show requesting an interactive device to identify more information about a specific query to be made to a publicly accessible source of information.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chen et al, as evidenced by Steele et al USPN. (20020046084). In analogous art, Steele et al whose invention is about a configurable multimedia information system that supports electronic commerce, disclose sending a request from a first recipient (system 10) to an interactive device (user with interactive device fig. 1 and 10), requesting said interactive device to identify more information about a specific query to be made to set publicly accessible source of information (Vendor)

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[page 9, paragraphs 0129-0134]. Giving the teaching of Steele et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chen et al by employing the system of Steele et al in order to provide users beneficial up-to-date information that is consistent with their preference of services and products.

As per claim 2, Chen et al teach a method as in claim 1, wherein said reformatting said information comprises assembling a message which includes some, but not all, of the information received from said publicly accessible source of information [page 1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058].

As per claim 3, Chen et al teach a method as in claim 1, wherein said reformatting comprises reformatting said information into a text message [Page 1, paragraphs 0014].

As per claim 5, Chen et al teach a method as in claim 2, wherein said interactive device also stores personal information associated with a user of the interactive device, and wherein said sending comprises sending a request for information which includes some of said personal information [paragraphs 0010-0014 and page 4, paragraphs 0047-0058. see paragraphs 0085 and 0100].

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As per claim 6, Chen et al teach a method as in claim 5, wherein said personal information which is sent, includes logon information and a password [Page 1, paragraphs 0011 and Page 6, paragraphs 0075-0085].

As per claim 7, Steele et al teach a method as in claim 6, further comprising signifying to said source of information an indication to purchase a product [paragraph 0063 and paragraphs 0131-0134].

As per claim 17, is a method with similar limitations as claim 1 above. Therefore, it is rejected with the same rationale.

As per claim 19, Chen et al teach the invention, wherein said reformatting comprises reformatting the information into an XML format [Page 4, paragraphs 0054].

As per claim 20, Chen et al teach the invention, wherein said reformatting the information comprises reformatting the information into a text format [Page 4, paragraphs 0055-0058].

As per claim 21, this claim includes similar limitation as in claim 1 above. Further Chen et al teach a method, comprising:

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Sending a text message for an e-mail pager (Fig. 1, pager 214 and 216), to a specified address (fig. 1, 100), said text message including text content indicating an action that the user wants to carry out on the internet [page1, paragraphs 0010-0011 Page 3, paragraphs 0039 and page 4, paragraphs 0053-61]; Second sending back a text message back to said email pager [page1, paragraph 0014 and page 4, paragraphs 0055-0059]; and after said second sending, at associated with said specified address, translating said text message into an actual operation to be carried out on the internet, and carrying out said operation on the terminal, and returning a result from said operation on the Internet to said e-mail pager [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058. See also paragraphs 0071-0074].

As per claim 23, Steele et al teach the invention as modified, wherein said second sending is a request for information of contents of said action [page 7, paragraph 0117 and 0131].

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al US. PUB. (20020177453) in view of Steele and further in view of Rajan et al USPN (6633910).

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As per claim 8, Rajan et al teach the invention, wherein said source information indicates a user's bank balance [Col. 13, lines 44-63 and col. 15, lines 50 and 62].

Although Chen and Steele show substantial features of the claimed invention as explained above, they do not explicitly show information indicating a user's bank balance.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chen and Steele, as evidenced by Rajan et al (6633910).

In analogous art, Rajan et al whose invention is about a system that allows virtually any Internet-based data to be accessed, restructured and then transmitted to wide variety of network-capable appliances, discloses a summarized version of a bank statements that is synchronized into the Memo Pad application on a Palm showing the balances of customer account at a bank [Col. 13, lines 44-63 and col. 15, lines 50 and 62]. Giving the teaching of Rajan et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chen et al and Steele by employing the system of Rajan et al so that users are notified in a real-time when his or her user-defined events such the user's net bank balance falls below a specified amount. Such a system would be a convenience to a user in that he or she would be conveniently

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made aware of the existence of new aggregated data and/or specific and user-defined events in data, before having to log on to the service to check for new data, or having other important work interrupted by an unscheduled data-push to an otherwise engaged peripheral device [Rajan col. 3, lines 28-41].

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al US. PUB. (20020177453) in view of Rajan et al USPN (6633910).

As per claim 9, Chen et al teach a method comprising:
sending a request for information from an interactive device (Fig. 1, 214) to a first recipient (Fig. 1, 100) and Page 1, paragraphs 0009-0014];
at said first recipient, using information from said request to query publicly accessible source information sending a request for information from an interactive device [Page 1, paragraphs 0009-0014];
receiving results from querying said source of information [Page 1, paragraphs 0011-0014];
Reformatting said result into a new form to said interactive device [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-0058];

wherein said reformatting said information comprises assembling a message which includes some, but not all, of the information received from said publicly accessible source of information [page1, paragraphs 0010-0014 and page 4, paragraphs 0047-0059. see also paragraphs 0071-0076].

Although Chen et al shows substantial features of the claimed invention including transcoding a retrieved raw content into the appropriate format (0010 and 0059), he does not explicitly show reformatting information according to a prestored template.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chen et al, as evidenced by Rajan et al (6633910).

In analogous art, Rajan et al whose invention is about a system that allows virtually any Internet-based data to be accessed, restructured and then transmitted to wide variety of network-capable appliances, discloses a unique capability of restructuring data and converting it from one format to a format specific to applications executable on a receiving device where an algorithm is employed that can take information from provided input data-templates and restructure the information to fit pre-designed and associated output data-templates that is stored in a storage facility for requesting user [col. 7, lines 56-64 and

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col. 8, lines 55-65]. Giving the teaching of Rajan et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chen et al by employing the system of Rajan et al in order to facilitate the format in which requested data is expected to be found and to enhance the support of different formats and applications.

As per claim 10, Chen et al teach a method as in claim 2, wherein said reformatting comprises reformatting said information into an XML form [Page 4, paragraphs 0014 and 0054].

Response to Arguments

In response to applicant's arguments in page 5, lines 5-7 that "Chen teaches away from requesting additional information, and certainly does not teach any specific way in which additional information could be requested in Chen's disclosed system" and that "one ordinary skill in the art would not combine Chen with Steele, or Chen with any other reference that showed obtaining additional information by sending another message" (page 7, lines 12-14). Examiner respectfully disagrees. Chen's system can readily support new functionality with applets, new devices

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with devlets, and new information spaces with infolets (¶ 0060). In addition, "The mobile device server 100 can receive messages and commands from these devices, access Internet services and information on behalf of a mobile user, and relay messages or Internet content back to the sending devices or other devices, as described more fully below" [0039]. Chen also teaches storing user profile such as user name, password and a list of device that the user registers with the mobile device server [0100]. Chen teaches where a devlet (a mobile device server interface, see fig. 9) can require additional information that tells the mobile device server how and when to access mobile devices [0076]. Chen uses an interactive system with variety of authentication techniques to authenticate mobile users depending upon the device or protocol used (¶ 0057 and 0085). In order to authenticate a user Chen's interactive system must ask additional information such as user ID and password. Chen's interactive system registers user username, password and a list of device to store a user profile [see 0100]. Therefore, it is clear that Chen can require additional information from mobile device. Hence it is obvious to one ordinary skill in the art at the time of the invention that when a user registers the above-mentioned information with a server system, the server system would ask such information.

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Giving the above explanation of how Chen can require additional information, it is obvious to one ordinary skill in the art to combine Chen with another reference such as Steele's interactive system.

Furthermore, the test for obviousness is not whether the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues "the proper question for the obviousness rejection... Under current law, the question is rather, "what is obvious" based on Chen - not what is possible based on Chen." (Page 7, lines 1-4). Examiner agrees with the applicant that the question is "what is obvious." As explained above, the examiner has established the evidence that Chen's interactive system can require additional information from mobile devices as stated in paragraph [0076]. Examiner also recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner has shown a suggestion and motivation as explained above and in more detail in the office action.

In response to applicant's argument that "Chen and Steele are non-analogous art." (Page 7, last paragraph), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case Steele teaches "As shown in FIG. 1, the invention consists of (1) a remotely programmable, microcomputer controlled multimedia device 20 in a vehicle with a wireless IP address for Internet access, (2) an Internet gateway network 30 that provides programming, information and Internet access to the multimedia device 20, and (3) one or more remote programming devices 40. [0017]. Steele also teaches using a remote computer 206 with an Internet connection 208, the user preferably logs into the Internet gateway network 30 in a known

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manner. If the user has never created an account before, he/she will first answer a series of questions to create a user profile. The user registers information about the multimedia device 20 itself (e.g., identification number, model, etc.), provide billing information, provide information about the vehicle 184 if the device is an OEM installation ..." [0101].

Applicant also argues "Moreover, one having ordinary skill in the art would not find any usable teaching about how an advertisement obtaining system could be used with a system that obtains information over the Internet." (Page 8, second paragraph]. Examiner respectfully disagrees. The system of Steele is similar to that of Chen in such that both systems obtain information over the Internet as explained above. Furthermore, Steele teaches, "It is yet a further object of the invention to add new personal information services (e.g., email, stock quotes, interactive audio games, etc) to the multimedia device 20 from a wireless Internet connection 60 by downloading applications." [0026]. In particular, both systems use wireless device to receive information over the Internet. Both system register with a wireless server to receive information such as news updates, weather, stock quotes, etc. [Steele 0110, fig. 3] and [Chen 0054 and 0062, fig. 1]. Therefore, Applicant's

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arguments that "one having ordinary skill in the art would not find any usable teaching about how an advertisement obtaining system could be used with a system that obtains information over the internet." (Page 8, paragraph 2) is moot.

Applicant argues in page 9, first paragraph that " nothing in Steele teaches or suggests asking for more information relative to a query to a publicly available database, where the system that is doing the querying requests more information about the query." and page 10 paragraph 2, that "while Steele does request additional information, it is not information about a specific query to be made.' It rather is information about fields to be populated within an advertisement." Examiner notes that the applicant repeatedly characterize Steele's invention as "teaching how to populate the fields in an advertisement that is going to be posted." Page 9, paragraphs 3-4 and page 10, paragraph 2. This is a mischaracterization of the invention of Steele. Steele teaches " a method of providing service or products in a communication network comprising the steps of providing a plurality of service or product options to an end user; consumers will receive services or products in exchange for receiving ads. The plurality of service or product options

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could include such things as location based services (roadside assistance, navigation, etc.), news updates, sports, weather, stock quotes, e-commerce transactions, web surfing minutes, discounts on products, frequent flier miles, free products (CD's, electronic equipment, gasoline), etc. in exchange for the end user receiving ads (voice, text or other medium) to a communication device." [0110]. Steele's invention is more than providing ads to a user, rather it is providing products and services such news updates, sports, weather, stock quotes, e-commerce transactions, web surfing minutes, discounts on products, frequent flier miles, free products (CD's, electronic equipment, gasoline), etc [0110].

Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Chen teaches sending a request for information from an interactive device (Fig. 1, 214) to a first recipient (Fig. 1, 100) [Page 1, paragraphs 0009-0013]; at said first recipient, using information from said request to query a publicly accessible source of information (Fig. 5, 352) [Page 1, paragraphs 0011-0014]. Steele

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teaches "a user can customize the way audio broadcasts and personal information service channels are organized in the vehicle's multimedia device 20, can request new personal information services be downloaded from the Internet gateway 30 to the multimedia device 20, and can retrieve information from the gateway 30 that he has stored there from the vehicle 184. The user can also access his custom profile and billing information records." [0020]. Steele clearly shows accessing and downloading information from the Internet. Steele also teaches a user of an interactive device sending a request message (query) to multimedia entertainment and information system 10 (publicly available source of information fig. 1, 60) (¶ 0111-0112, page 7), requesting from said interactive device to identify more information about the request message (query) to be made to said publicly accessible source of information "if the system 11 needs more information from the user is proceeds to obtain that information at step 706. For example, perhaps gauge information from the vehicle is required, but that information was not supplied in the original update message." [¶ 0129-0132, page 9].

In response to applicant's argument in page 12, second paragraph that "nothing in Steele suggests a confirmation of contents".

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Applicant's attention is directed to (paragraph 0117, page 7) where Steele discloses messages requiring user interaction and ensuring that a required confirmation is received if it is determined that confirmation is required. Steele further teaches "the user, preferably sends a receipt or a confirmation of the receipt back to the system 11" [0131].

In response to Applicant's arguments in page 12 that "claim 8 depends from claim 1, hence the subject matter of claim 1 is part of claim 8. Hence, the rejection of claim 8 is facially defective: the rejection of claim 8 does not include the Steele reference..." Examiner agrees with the Applicant regarding claim 8. Claim 8 should have been rejected over Chen in view of Steele and further in view of Rajan. As indicated in the detailed action above, Claim 8 is now rejected over Chen in view of Steele and further in view of Rajan. Therefore, Applicant's arguments regarding claim 8 is moot.

In response to Applicant's arguments in page 11, last paragraph that "claim 17 specifies receiving a request from a publicly available source of information, sending a request to the client for more information detail about that request." Examiner notes that claim 17 do not specify "receiving a request from a

publicly available source of information" rather claim 17 specifies receiving a request from a first client for information from a publicly available source ... However in light of the response to the arguments in claim 1, claim 17's arguments are moot. See the response above as it relates to sending a request to the client for more detail about that request (requesting additional information of a specific query ... recited in claim1).

Regarding claim 21, Applicant in essence argues Chen and Steel are not operatively combinable. The same arguments made in claim 1. Therefore, Applicant is referred to the response giving in claim 1 above.

In response to applicant's argument in page 12, last paragraph to page 13, first paragraph that "Rajan has no teaching or suggestion of how a user could request information, from their pager, about a bank balance... [Rajan] teaches nothing about a query being formed from the pager itself." Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986). Rajan is relied on to show source information indicating a user's bank balance. See the rejection made on claims 8 and 5 in the office action. Claim 8 requires source information indicating a user's bank balance, which has been addressed in the detailed rejection above. Regarding requesting information and query are taught by Chen and Steele as indicated in claim 1 above.

In response to applicant's argument in page 13, second paragraph that " the Rajan does teach that information can be reformatted between templates,... there is no teaching or suggestion of reformatting information according to a template for an interactive device, as claimed." Examiner contends that Rajan discloses a unique capability of restructuring data and converting it from one format to a format specific to applications executable on a receiving device where an algorithm is employed that can take information from provided input data-templates and restructure the information to fit pre-designed and associated output data-templates that is stored in a storage facility for requesting user [col. 7, lines 56-64 and col. 8, lines 55-65]. "Output templates contain device specific data that is ready for transmission to target devices such as devices 39-47 of FIG. 1 (devices 39047 include pager 39, notebook

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computer 41, PDA 47 and a cellular telephone 43). Rajan clearly teaches reformatting information according to a template for an interactive device.

Regarding claim 10, Applicant argues that "Rajan certainly does not teach XML could be used, but it teaches nothing about reformatting into XML: It only teaches that the information can be received initially in XML." Examiner notes Chen is relayed upon to teach the limitation in claim 10. However, Rajan teaches, " employing an algorithm that can take information from provided input data-templates and restructuring the information to fit pre-designed and associated output data-templates. The input template renders the original data into a proprietary language similar to HTML and XML. The proprietary language or code expresses the original data in a standard format that may then be manipulated by algorithm." Therefore, Rajan restructures data and renders the original data into propriety language such as XML. (Col. 8, lines 42-65).

Hence, the teachings of Chen in view of Steele and Chen in view of Rajan disclose all the argued limitations of the claimed invention.

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For the reasons above, the rejection should be affirmed.

YB

September 13, 2006

Conferees

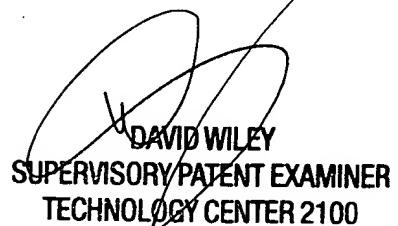


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